

REMARKS

Claims 1-22 remain pending in the application.

The Applicants respectfully request the Examiner to reconsider earlier rejections in light of the following remarks. No new issues are raised nor is further search required as a result of the changes made herein. Entry of the Amendment is respectfully requested.

Claim 1-4, 7, 9-11, 14-17, 19, 20 and 22 over Chamberlin in view of Villa-Real and Sacca

In the Office Action, claim 1-4, 7, 9-11, 14-17, 19, 20 and 22 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Chamberlin et al., U.S. Patent No. 4,817,127 (“Chamberlin”) in view of Villa-Real, U.S. Patent No. 4,481,382 (“Villa-Real”), and further in view of Sacca, U.S. Patent No. 5,692,042 (“Sacca”). The Applicants respectfully traverse the rejection.

The Applicants respectfully suggest that the need to combine as many as three (3) separate patents to allegedly arrive at the presently claimed invention is evidence of the non-obviousness of the present invention.

Claims 1-4, 7 and 9-11 recite, *inter alia*, hearing of a message playback signal and a receive signal by a local user of a speakerphone while allowing simultaneous recording of the receive signal from a telephone line.

The Office Action alleges that Chamberlin’s playback module is a tape recorder and that the tape recorder plays a pre-recorded outgoing message to a far end user (Office Action, page 12). Moreover, the Examiner alleges that it is inherent that the outgoing message and the advisory message is recorded by a user (Office Action, page 12).

Under the doctrine of necessary inherency, anticipation may be established when a single prior art reference fails to disclose the claimed invention ipsisimilis verbis, but the natural and invariable practice of the reference would necessarily inherently meet all the elements of the claim. See, e.g., Verdegaal Bros., Inc. v. Union Oil Co. of Cal., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987); In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir.

1986); Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 227 USPQ 245 (Fed. Cir. 1985); Ethyl Molded Products Co. v. Betts Package Inc., No. 85-111 1032 (D.C.E.D. Kent. 1988). The doctrine of inherency is available only when the inherency can be established as a certainty; probabilities are not sufficient. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); In re Chandler, 254 F.2d 396, 117 USPQ 361 (CCPA 1981); Ethyl Molded Prod. Co. at 1032.

As evidence of an alleged inherency, the Examiner interprets Chamberlin as being capable of playing a pre-recorded outgoing message and advisory message to a far end user, citing col. 16, lines 58-64 and col. 21 lines 27-36. These particular passages of Chamberlin disclose a recording/playback module that is used to record an incoming telephone call while a second recording/playback module is used to transmit an outgoing message as done in an automatic telephone answering machine.

As the Examiner acknowledges, Chamberlin fails to disclose an outgoing message and an advisory message that are recorded by a user. The Examiner has inappropriately applied inherency in a §103(a) rejection. The Applicants respectfully request the improperly based rejection be withdrawn.

Moreover, Chamberlin discloses two independent modules that separately connect to two distinct phone lines. A speakerphone module interacts with a first playback/record module connected to a first phone line used to record an incoming telephone call. A distinct second record/playback module is connected to a second phone line is used to transmit an outgoing message, as is done in an automatic telephone answering machine (col. 16, lines 58-64). The first recording/playback module functions as a recorder of an incoming message while the second record/playback module functions to play back a prerecorded outgoing announcement message transmitted to another telephone (Chamberlin, col. 21, lines 27-36).

Therefore, on a given telephone line Chamberlin performs either a play function or a record function, with only the record function connected to a speakerphone module. Chamberlin fails to disclose or suggest performing hearing of a message playback signal and recording functions while allowing

simultaneous performing of a record function, i.e., hearing of a message playback signal and a receive signal by a local user of a speakerphone while allowing simultaneous recording of the receive signal from a telephone line, as recited by claims 1-4, 7 and 9-11.

Moreover, the piecemeal application of Chamberlin is improper: the reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention (see MPEP 2141.02 at page 2100-95 (Rev. 1, Feb. 2000) (citing W.L. Gore & Associates, Inc. v. Garlock, Inc., 22 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984))). Chamberlin teaches away from performing multiple actions for any particular user on a telephone line simultaneously by disclosing that the recording/playback modules perform separate functions on separate telephone lines for separate users.

“Teachings of references can be combined only if there is some suggestion or incentive to do so.” In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). Chamberline uses two record/playback modules on separate telephone lines. Neither Chamberlin, Villa-Real nor Sacca provide any motivation to modify Chamberline's invention to allow hearing of a message playback signal and a receive signal by a local user of a speakerphone while allowing simultaneous recording of the receive signal from a telephone line, as recited by claims 1-4, 7 and 9-11.

The Office Action correctly acknowledged that Chamberlin fails to disclose a message playback signal that is combined with a receive signal by a summer, allowing simultaneously hearing by a local user of a speakerphone (Office Action, page 3). The Office Action relies on Villa-Real and Sacca to allegedly make up for the deficiencies in Chamberlin to arrive at the claimed invention. The Applicants respectfully disagree.

Villa-Real discloses use of a synthesized voice or speech message (col. 13, lines 6-18), **NOT** disclosed as being recorded by a user. In fact, since the message is simply an announcement that the phone conversation is being recorded, with the same message given every time a phone conversation is

being recorded, there would be no purpose for having a user record such an announcement. Moreover, allowing a user to record such a message would allow a user to record a message that does not inform a party to the conversation that the conversation is being recorded, completely mooting the purpose of such a feature.

Moreover, even if Villa-Real disclosed that the announcement message is a message that is recorded by a user (which Villa-Real does not), such a user recorded voice message is played for users using a conventional telephone, **NOT** a speakerphone. Applying the disclosure of Villa-Real to Chamberlin would at best only allow the users to hear the user recorded announcement message while Chamberlin is being used as a conventional telephone, **NOT** when used as a speakerphone, as recited by claims 1-4, 7 and 9-11.

Villa-Real can not disclose a message playback signal that is combined with a receive signal by a summer, allowing simultaneously hearing by a local user of a speakerphone, as alleged by the Examiner, since Villa-Real fails to even mention a speakerphone. Even if Villa-Real discloses a message playback signal that is combined with a receive signal by a summer, allowing simultaneously hearing by a local user, Villa-Real fails to make up for the deficiency in Chamberlin. Villa-Real fails to disclose or suggest hearing of a message playback signal and a receive signal by a local user of a speakerphone **while allowing simultaneous recording** of the receive signal from a telephone line, as recited by claims 1-4, 7 and 9-11.

Sacca discloses a combined source signal comprising one or more alternate signal sources, e.g., tape playback, tones, synthesized speech, etc. for transmission over the telephone line. Sacca's invention is directed toward transmitting a plurality of signals. Sacca fails to disclose a record module, much less hearing of a message playback signal and a receive signal by a local user of a speakerphone **while allowing simultaneous recording** of the receive signal from a telephone line, as recited by claims 1-4, 7 and 9-11.

Even if the theoretical combination of Chamberlin, Villa-Real and Sacca were obvious (which it is not), the combination would **at best** result in a

telephone module interacting with a first recording/playback module used to record an incoming telephone call while a second recording/playback module would be used to transmit an outgoing message on a separate telephone line as is done in an automatic telephone answering machine (Chamberlin), an announcement message is played when a conversation is being recorded by a conventional telephone (Villa-Real), and transmitting a plurality of signals from a plurality of sources (Sacca). The theoretical combination of Chamberlin, Villa-Real and Sacca fails to disclose, teach or suggest hearing of a message playback signal and a receive signal by a local user of a speakerphone while allowing simultaneous recording of the receive signal from a telephone line, as recited by claims 1-4, 7 and 9-11.

Claims 14, 15, 17 and 20 recite, *inter alia*, recording a receive signal during a conversation on a speakerphone while allowing simultaneous summing of a playback message signal comprising a user recorded voice message together with a hybrid echo canceled signal.

As discussed above, Chamberlin discloses a modular dictation/transcription system with a telephone module that has speakerphone capability.

The Office Action correctly acknowledged that Chamberlin fails to disclose recording a receive signal while the receive signal is summed with a message playback signal during a telephone conversation (Office Action, page 6). The Office Action relied on Villa-Real and Sacca to allegedly make up for the deficiencies in Chamberlin to arrive at the claimed invention. The Applicants respectfully disagree.

As discussed above, even if Villa-Real disclosed that the pre-recorded advisory message is recorded by a user (which Villa-Real does not), such a user recorded message is played for users using a conventional telephone, **NOT** a speakerphone. Villa-Real fails to even mention a speakerphone. Applying the disclosure of Villa-Real to Chamberlin would at best only sum a user recorded voice message with a signal in a receive path when the telephone is used as a conventional telephone, **NOT** when recording on a speakerphone, as recited by claims 14, 15, 17 and 20.

As discussed above, Sacca discloses a combined source signal comprising one or more alternate signal sources, e.g., tape playback, tones, synthesized speech, etc. for transmission over the telephone line. Sacca's invention is directed toward transmitting a plurality of signals. Sacca fails to disclose recording anything during use of the speakerphone, much less recording a receive signal during a conversation on a speakerphone while allowing simultaneous summing of a playback message signal comprising a user recorded voice message together with a hybrid echo canceled signal, as recited by claims 14, 15, 17 and 20.

Neither Chamberlin, Villa-Real nor Sacca, either alone or in combination, disclose, teach or suggest recording a receive signal during a conversation on a speakerphone while allowing simultaneous summing of a playback message signal comprising a user recorded voice message together with a hybrid echo canceled signal, as recited by claims 14, 15, 17 and 20.

Claims 16 and 19 recite, *inter alia*, recording an incoming voice signal associated with a telephone call during a conversation on a speakerphone while allowing simultaneous injecting of a played back voice message into a telephone call.

The Office Action correctly acknowledged that Chamberlin fails to disclose playing back a voice message during a telephone conversation, as recited by claims 16 and 19. The Office Action relies on Villa-Real and Sacca to allegedly make up for the deficiencies in Chamberlin to arrive at the claimed invention. The Applicants respectfully disagree.

As discussed above, even if Villa-Real disclosed that the pre-recorded advisory message is recorded by a user (which Villa-Real does not), such a user recorded message is played for users using a conventional telephone, **NOT** a speakerphone. Villa-Real fails to even mention a speakerphone. Chamberlin modified by Villa-Real would at best result in a speakerphone performing either a play function or a record function, **NOT** recording during a conversation on a speakerphone while allowing simultaneous injecting of a played back voice message into a telephone call, as recited by claims 16 and 19.

As discussed above, Sacca's invention is directed toward transmitting a plurality of signals. Sacca fails to disclose or suggest recording an incoming voice signal, much less recording an incoming voice signal associated with a telephone call during a conversation on a speakerphone while allowing simultaneous injecting of a played back voice message into a telephone call, as recited by claims 16 and 19.

Neither Chamberlin, Villa-Real nor Sacca, either alone or in combination, disclose, teach or suggest recording an incoming voice signal associated with a telephone call during a conversation on a speakerphone while allowing simultaneous injecting of a played back voice message into a telephone call, as recited by claims 16 and 19.

Claim 22 recites, *inter alia*, while a speakerphone operation is activated, allowing simultaneously recording of a conversation utilizing the speakerphone and playing back a voice message recorded on a near end telephone system.

As discussed above, Chamberlin performs either a play function or a record function, with only the record function connected to a speakerphone module. Chamberlin fails to disclose or suggest performing hearing and recording functions simultaneously while using a speakerphone, i.e., while a speakerphone operation is activated, allowing simultaneous recording of a conversation utilizing the speakerphone and playing back a voice message recorded on a near end telephone system, as recited by claim 22.

The Office Action relies on Villa-Real and Sacca to allegedly make up for the deficiencies in Chamberlin to arrive at the claimed invention. The Applicants respectfully disagree.

As discussed above, even if Villa-Real disclosed that the pre-recorded advisory message is recorded by a user (which Villa-Real does not), such a user recorded message is played for users using a conventional telephone, NOT a speakerphone. Villa-Real fails to even mention a speakerphone. Chamberlin modified by Villa-Real would at best result in playing back a voice message recorded on a near end telephone system while a call is

established on a conventional telephone, **NOT** on a speakerphone, much less while recording a conversation utilizing the speakerphone, as recited by claim 22.

As discussed above, Sacca's invention is directed toward transmitting a plurality of signals. Sacca fails to disclose perform any type of recording while a speakerphone is activated, much less **allowing simultaneous recording** of a conversation utilizing the speakerphone and playing back a voice message recorded on a near end telephone system, as recited by claim 22.

Neither Chamberlin, Villa-Real nor Sacca, either alone or in combination, disclose, teach or suggest while a speakerphone operation is activated, **allowing simultaneously recording** of a conversation utilizing the speakerphone and playing back a voice message recorded on a near end telephone system, as recited by claim 22.

An advantage of being able to playback a voice message while recording a conversation using a speakerphone is, e.g., to create a record of a response to a user recorded voice message. A person listening to a voice message may comment on the voice message while a conversation is taking place. Being able to record a listener's response to a voice message while it is playing prevents the listener from later denying a response after having time to think about what was said. The cited prior art fails to disclose, teach or suggest such an advantage.

Accordingly, for at least all the above reasons, claim 1-4, 7, 9-11, 14-17, 19, 20 and 22 is patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 5, 6, 8, 12, 13, 18 and 21 over Chamberlin in view of Villa-Real, Sacca and Li

In the Office Action, claims 5, 6, 8, 12, 13, 18 and 21 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Chamberlin, in view of Villa-Real, in view of Sacca and further in view of Li, U.S. Patent No. 5,612,996 (“Li”). The Applicants respectfully traverse the rejection.

Claim 5, 6, 8, 12, 13 18 and 21 are dependent on claims 1, 16 and 19, and is allowable for at least the same reasons as claims 1, 16 and 19.

Claims 5, 6, 8, 12 and 13 recite, *inter alia*, hearing of a message playback signal and a receive signal by a local user of a speakerphone **while allowing simultaneous** recording of the receive signal from a telephone line. Claims 18 and 21 recite, *inter alia*, recording an incoming voice signal associated with a telephone call during a conversation on a speakerphone **while allowing simultaneous** injecting of a played back voice message into a telephone call.

As discussed above, neither Chamberlin, Villa-Real nor Sacca, either alone or in combination, disclose, teach or suggest recording during use of a speakerphone **while allowing simultaneous** hearing and injecting of a playback voice message into a telephone call, as recited by claims 5, 6, 8, 12, 13, 18 and 21.

The Office Action relies on Li to allegedly make up for the deficiencies in Chamberlin, Villa-Real nor Sacca to arrive at the claimed invention. The Applicants respectfully disagree.

Li appears to disclose a loop gain processing scheme for a speakerphone (Abstract). A system loop gain is determined according to two echo feedback paths within the speakerphone system (Li, Abstract). Li teaches the prior art had used a gain module comprised of an automatic gain control in conjunction with a receive channel gain adjustment (Li, Fig. 1; col. 3, lines 44-52).

Li discloses gain control for a speakerphone. Li fails to disclose any type of record module, much less performing recording during a speakerphone operation, as recited by claims 5, 6, 8, 12, 13, 18 and 21.

Neither Chamberlin, Villa-Real, Sacca nor Li, either alone or in combination, disclose, teach or suggest recording during use of a speakerphone

while allowing simultaneous hearing and injecting of a playback voice message into a telephone call, as recited by claims 5, 6, 8, 12, 13, 18 and 21.

Accordingly, for at least all the above reasons, claims 5, 6, 8, 12, 13, 18 and 21 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,



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